



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/954,464	09/14/2001	Kenneth F. Gay	GAY 2-009-3	8908

7590 01/16/2003

Gerald L. Smith  
Mueller and Smith, LPA  
7700 Rivers Edge Drive  
Columbus, OH 43235

EXAMINER

TRAN, KHOA H

ART UNIT

PAPER NUMBER

3634

DATE MAILED: 01/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/954,464

Applicant(s)

GAY ET AL.

Examiner

Khoa Tran

Art Unit

3634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) 37-41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 12-23, 26-30, 33-36 and 42-47 is/are rejected.
- 7) ☐ Claim(s) 10, 11, 24, 25, 31 and 32 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Election/Restriction***

Applicant's election with traverse of Group I, claims 1-36 and 42-47, in Paper No. 3 is acknowledged. The traversal is on the grounds that the search of one group, Group I, will necessarily encompass the other since they are related to the other in operation or effect. This argument is not found to be persuasive because applicant has failed to show why the instant claims of Group I and Group II are not patentably distinct and the provide a reason as why there is not a serious burden involves in the field of a search between two Groups of two separate status claims locate in two separate classes of classifications. Further, applicant has failed to show that the search is the same or that a coextensive search is a reason for not requiring a restriction requirement. Applicant also failed to provide any reasoning as to why the method claims must be searched and examined in determining the patentability of the product claims, especially when patentability of the product is based solely on the structural recitations thereof. It should be noted that in finding the structure of the product does not entail also finding the claimed process steps of the method claims. Does applicant's asserting that the method of Group II is obvious on its face and that the examiner need not apply prior art that specifically meets each and every method step recited? If the applicant is of a different view, then applicant needs merely clearly state on the record that Group I and Group II are not patentably distinct. Neither the examiner nor the applicant needs to present any reasoning.

Applicant's general allegations to the related concept of novelty between Group I and Group II do not overcome the criteria for restriction. The requirement is still

Art Unit: 3634

deemed proper and is therefore made FINAL. Accordingly, claims 37-41 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Species.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-36 and 42-47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With respect to claim 1, line 32, claim 13, line 33, claim 27, lines 33, and claim 41, line 8, there is no antecedent basis for "said vertical support".

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-9, 12-23, 26-30, 33-36, and 42-47 are rejected under the judicially created doctrine of double patenting over the U. S. Patent No. 6, 302,282 in view of the U. S. Patent No. 5,299,698. The U. S. Patent No. 6, 302,282 discloses an open frame display shelf assembly having shelves that has forward signs (50) and dividers (58) that meet all limitations of the claims. For example, the wires shelves of the U. S. Patent No. 6, 302,282 each comprising a plurality of base rods (96), a plurality of rod beams (98), a plurality of transverse load rods (100); a sidewall (90, 92), a forward wall (86) and a rearward wall (88) each having a receiving gap therebetween (120, 60) the forming rods; a bracket assembly (39) connectable with the respective rear of sidewall; a pivotable sign (50) mount to the forward wall forming rods; a coupler (244 and 246) engage with the wall forming rods to alter the slope of the sign engaging surface, see Figures 4, 9 and 10. The U. S. Patent No. 6, 302,282 does not teach a plurality of rods forming parallelogram loops signs mount between gaps on the shelf. However, the U. S. Patent No. 5,299,698 a plurality of rods forming parallelogram loops signs (72) mount between gaps on the shelf. See Figures 1, 3, and 4. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to provide the shelf of U. S. Patent No. 6, 302,282 with parallelogram loops signs as taught by U. S. Patent No. 5,299,698 in order to have a sign that is extended above the shelf for displaying information.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Gay ('562), Cain et al., Black, Jr., Young, Jr., Metcalf, Loew,

Henke et al., Parker, Loy, Roesler, Soporowski, Trulaske, Sr., Merl, and S. Ciborowski, are cited to show devices having similar configurations of design.

***Allowable Subject Matter***

Claims 10, 24, and 31 would be allowable if rewritten to include all of the limitations of the base claim and any intervening claims.

The following is an examiner's statement of reasons for allowance:

Claims 10, 24, and 31 are allowable because there is no prior art of record that teaches or suggests an open frame display shelf assembly possessing the entire combination of features specified by the claims. In particular, there is no teaching or suggestion of "a flat visual display support. . . a pivot connector extending from said display support upper edge and including a pivot hook pivotally engageable with a select said forward base rod", see entire claims 10, 24, and 31.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khoa Tran whose telephone number is (703) 306-3437. The examiner can normally be reached on Monday through Thursday from 8:30 A.M. to 7:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola, can be reached on (703) 308-2686. The fax phone number for this Group is (703) 305-3597 or (703) 305-3598.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2168.

If the applicant is submitted by facsimile transmission, applicant is hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and M.P.E.P. 502.02). In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a deposit account, can be submitted by facsimile transmission. Responses requiring a fee which applicant is paying by check **should not be** submitting by facsimile transmission separately from the check. Responses submitted by facsimile transmission should include a Certificate of Transmission (M.P.E.P 512). The following is an example of the format the certification might take:

I hereby certify that this correspondence is being facsimile transmitted to the  
Patent and Trademark Office

Fax No. \_\_\_\_\_ On \_\_\_\_\_  
(Date)

Type or printed name of person signing this certificate:

\_\_\_\_\_  
\_\_\_\_\_

(Signature)

Furthermore, please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response after your response has been transmitted by facsimile will only cause further unnecessary delays in the processing of your application; duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

Khoa Tran

January 12, 2003

A handwritten signature in black ink, appearing to read 'Alvin Chin-Shue', with a stylized, cursive script.

**Alvin Chin-Shue**  
**Primary Examiner**